

Appln No. 09/694,079
Amdt date June 8, 2004
Reply to Office action of March 8, 2004

REMARKS/ARGUMENTS

Claims 26-28, 33-43, and 49-74 will be pending in this application upon entry of the above amendments. Claims 52-74 have been added. Claims 1-25, 29-32, and 44-48 have been canceled. The amendments find support in the original specification, claims, and drawings. No new matter has been added. In view of the above amendments and remarks that follow, reconsideration, reexamination, and an early indication of allowance of the now pending claims 26-28, 33-43, and 49-74 are respectfully requested.

FIG. 2D has been amended to correct a typographical error. No new matter has been added. Entry of this amendment is respectfully requested.

The Examiner rejects claims 26-28, 33, 35-43, and 49-51 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,615,408 (Kaiser) in view of U.S. Patent No. 6,415,438 (Blackketter). Applicant respectfully traverses this rejection.

Independent claim 28 recites "[a] hyperlinked reception system comprising: a receiver . . . wherein said receiver decodes a digital broadcast signal to recover a video signal and annotation data . . . wherein said annotation data comprises a plurality of annotations having equal timing information, and said viewer request comprises an indication as to which annotation of said plurality of annotations is to be displayed." (Emphasis added). The Examiner acknowledges that Kaiser fails to disclose the recited annotation data. To address this deficiency, the Examiner relies on the disclosure in column 10, lines 1-12 of Blackketter that teaches that triggers may be

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associated with time attribute values that indicate the life span of the triggers. (See, Office action p. 3, lines 11-13). The Examiner contends that such life spans for triggers "clearly permits the equal timing information of annotation data . . . in that one would readily recognize that equal timing is an inherent feature of the system." (Id.; emphasis added).

It is well settled that "[t]he mere fact that references can be . . . modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." In re Mills, 916 F.2d 680 (Fed. Cir. 1990) (emphasis in original). In the Mills case, the claims were directed to an apparatus for producing an aerated cementitious composition by drawing air into the cementitious composition by driving the output pump at a capacity greater than the feed rate. The prior art reference taught that the feed means could be run at a variable speed. The court, however, found that this did not require that the output pump be run at the claimed speed so that air would be drawn into the mixing chamber and be entrained in the ingredients during operation. In making this finding, the court stated that although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." (Id., at 682).

Applicant further disagrees "that one would readily recognize that equal timing is an inherent feature of the system." To support a rejection based on inherency, the Examiner must provide factual and technical grounds establishing that the inherent feature necessarily flows from the teachings

Appln No. 09/694,079

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of the prior art. In re Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int. 1990). "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." M.P.E.P. § 2112. The Examiner has not provided any factual or technical grounds as to why life spans associated with triggers requires annotation data that "comprises a plurality of annotations having equal timing information."

The Examiner concludes that "it would have been obvious . . . to modify Kaiser by having equal timing information for annotation data as taught by Blackketter in order to present the triggers to the user in an effective and predicable fashion" (Id. at lines 13-17). Contrary to the Examiner's position, Kaiser already provides a mechanism for presenting triggers to the user, and Blackketter provides no motivation to deviate from the mechanism taught by Kaiser. If anything, the motivation to modify Kaiser in the manner suggested by the Examiner would appear to come from Applicant's disclosure itself. However, it is well settled the suggestion or motivation to make the combination or modification must be found in the prior art, and not in Applicant's own disclosure. M.P.E.P. § 2143.

For the reasons stated above, Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness for independent claim 28. Applicant therefore submits that claim 28 is in condition for allowance.

Appln No. 09/694,079
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Claims 26-27, 33-43, and 49-51 are also in condition for allowance because they depend on an allowable base claim, and for the additional limitations contained therein.

Claims 1-11, which had been previously canceled, have been reinstated into the application as claims 64-74 with amendments. Previous claim 1 (now claim 64) has been amended, however, to recite "an annotation source providing annotation data including image overlay data for visually identifying an object appearing in a video frame." Applicant submits that none of the cited references teach or suggest the limitations of the now claim 64, and is therefore in condition for allowance.

Claims 65-74 are also in condition for allowance because they depend on allowable base claim, and for the additional limitations contained therein.

In view of the above amendments and remarks, Applicant respectfully requests allowance of the now pending claims 26-28, 33-43, and 49-74.

Respectfully submitted,
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